

REMARKS

The applicants have reviewed the Final Action mailed by the Office on 9 March 2004 and the art cited therein, along with the Advisory Action mailed by the Office on 6 July 2004. The applicants submit this paper in connection with a Request for Continued Examination (RCE),
5 and request entry and favorable consideration of this response.

Independent claims 21 and 68 stand rejected under § 102(b) as being anticipated by Malec. The applicants respond to these rejections as follows, discussing several features that are not believed shown by Malec. Based on any one of these reasons, the applicants submit that Malec does not support a § 102(b) rejection of these independent claims because it does not
10 disclose these features as recited in these claims. The applicants thus request reconsideration and withdrawal of the rejections of these two independent claims, and all claims depending therefrom, to the extent they are based on Malec.

The applicants also include comments on the applicability of the Fano reference to dependent claims 205 and 207.

15 New claims 208-223 are added herein to recite additional features not believed shown by the cited art, as discussed in more detail below

1. *Regarding independent Claim 21, Malec Does Not Determine Its Offered Item Based On The User's Geographic Position, The User's Identity, And A Further Data Element.*

20 The applicants quote the following passage from claim 21 for convenience of discussion:
“utilizing at least in part the geographic position of the user, the at least further data element, and the identity of the user to determine the at least one offer for the item in real time with the primary transaction;”

25 As recited in this passage, the claimed invention utilizes data representing all three listed criteria in selecting the offered item: first, the geographic position of the user; second, the further data element related to the user; and finally, the identity of the user. To the extent that Malec discloses a given offered “item”, Malec does not appear to use all three of these criteria when selecting its “item”. More particularly, assuming the applicants’ claimed “items” are interpreted to correspond to Malec’s coupons, targeted advertisements, and/or awarded loyalty points (Malec, column 24, lines 40-56), Malec does not disclose using all three of the claimed

inputs to select such coupons, targeted advertisements, and/or awarded loyalty points. Further, assuming that the applicants' claimed "items" are read to correspond to the messages displayed on Malec's SCD electronics 514 in response to signals from Malec's trigger transmitters 512, these messages are not selected using all three of the claimed inputs. On at least this basis,

5 Malec does not meet the above-quoted feature, and thus does not support a § 102(b) rejection of claim 21 and all claims depending therefrom.

Turning to Malec's "coupons, targeted advertisements, and/or awarded loyalty points" in more detail, it appears that Malec can identify the user only via the smart card reader referenced in column 24, lines 40-56. Even assuming, only for the purposes of this discussion, that the 10 demographic data stored on Malec's smart cards corresponds to the "further data element" recited in the applicants' claims, and further assuming that the coupons, targeted advertisements, and/or awarded loyalty points referenced by Malec correspond to "coupons, advertisements, and loyalty programs" as recited in the applicants' claims, the role (if any) played by the geographic position of the shopper in determining which of these "coupons, advertisements, and loyalty 15 programs" are selected and offered to the shopper is unclear, as discussed further in the next paragraph. Instead, it appears that Malec's "coupons, advertisements, and loyalty programs" are selected based on, at most, the identity of the shopper swiping the smart card and whatever demographic information is stored on the smart card, irrespective of the shopper's position within the store. Thus, even under this hypothetical interpretation, Malec uses only, at most, two 20 of the criteria listed in claim 21 (the identity of the user and further data element) to select its coupons, advertisements, and loyalty programs, and accordingly fails to meet all features recited in the above-quoted language from claim 21.

Turning to Malec's display of messages on its SCD electronics 512 in more detail, it appears that Malec can determine the shopper's position within the store only by using the 25 trigger transmitters 512, which communicate with the transceiver electronics mounted on the respective shopping carts. However, the data obtained using Malec's transmitters 512 do not appear to be combined as inputs with the identification data and demographic data, obtained using Malec's smart card reader discussed in the previous paragraph, to select which messages to display on the SCD electronics 514. Malec's only explicit teachings regarding the data obtained 30 via the smart card reader appears in column 24, lines 40-56. While Malec discloses "target[ing] different advertisements to this cart based on the demographic information" (Malec, column 24,

lines 53-54), this does not explicitly teach or fairly suggest that the position data for the user is combined as input with the identity data and the further data element in selecting such “advertisements”. Moreover, the applicants can locate no teaching in Malec to combine or integrate this identity or demographic data with data obtained using the transmitters 512 to select 5 the messages for display on the cart’s SCD electronics 514. Accordingly, it is not clear how, if at all, the data obtained using the trigger transmitters 512 plays into the selection of the “items” discussed in the previous paragraph.

Put another way, the applicants submit that Malec does not clarify whether the SCD electronics 514 produce the “advertisements”, “coupons”, etc. irrespective of the shopper’s 10 position or location within the store, or whether the shopper’s position truly is an input into selecting what is presented to the shopper. However, the applicants submit that Malec must do so to anticipate the above-quoted passage from independent claim 21. Accordingly, on at least this basis, the applicants request reconsideration and withdrawal of the § 102(b) rejections of claim 21, and all claims depending therefrom, to the extent these rejections are based on Malec.

15 2. *Regarding Each Of The Pending Claims, Malec Does Not Disclose Obtaining Data Representing A True “Geographic Position” Of The User, As Recited In The Claims.*

Each of the pending claims recites various aspects of obtaining and processing data representing a geographic position of the user. In comparing these recitations to Malec, the 20 applicants submit that Malec discloses a system that detects a shopper’s proximity to a specific department or section in a grocery store, rather than identifying the shopper’s location in a true geographic or physical sense. More particularly, the Malec trigger transmitters each emit a unique signal having a unique signature, which when received by the shopper’s cart, serve as an index into a database to retrieve the appropriate message for display to the user. Thus, when the 25 shopper approaches a transmitter in, for example, the bread aisle, the unique signature or signal from that transmitter causes the cart display electronics to display bread-specific messages. However, if the bread aisle is relocated within the store, either the trigger transmitter can be moved to the new location, or a different trigger transmitter at the new location can be 30 configured to “trigger” the display of the bread-specific messages on the display when carts pass the new location. In either scenario, Malec’s trigger transmitters and related cart display electronics serve more as a proximity detector system that indicates a shopper’s relative position

within the larger framework of a structure such as grocery store, rather than the shopper's more absolute or physical position in the sense conveyed by the applicants' claim language "geographic position". On at least this basis, the applicants request reconsideration and withdrawal of the § 102(b) rejections of the claims pending in this case, to the extent such rejections are based on Malec.

5 3. *Regarding Independent Claim 68, Malec Does Not Determine Its Offered Item Based On The User's Geographic Position And A Further Data Element.*

The applicants quote the following passage from claim 68 for convenience of discussion:

10 "utilizing at least in part the geographic position of the user and the at least further data element to determine the at least one offer for the item in real time with the primary transaction,"

15 Unlike claim 21, claim 68 does not require utilizing the user's identity in determining the item to offer to the user. Nevertheless, the applicants submit that Malec fails to disclose the features recited in this passage from claim 68, for reasons similar to those discussed above in connection with claim 21. The applicants submit that Malec fails to teach utilizing demographic data captured from its smart card readers (assuming only for this discussion that this demographic data corresponds to the applicants' recited "further data element") and position data obtained using the trigger transmitters 514 and related transceiver electronics, (assuming only for this discussion that this data is an analogue for the applicants' recited "geographic position"), in selecting the following two elements:

20 (1) what data to present on the cart display electronics 512, or
(2) which coupons, targeted advertisements, or loyalty points to award the shopper.

25 It appears that Malec chooses the first element based only on the data relating to the trigger transmitters 514, and chooses the second element based only on the data captured from the smart card reader. However, the applicants submit that Malec must utilize both streams of data to select one of these elements to meet the features recited in the above passage from claim 68. On at least this basis, the applicants submit that Malec does not meet all features recited in claim 68, and therefore request reconsideration and withdrawal of the § 102(b) rejection of claim 68, and all claims depending therefrom, to the extent such rejections are based on Malec.

4. *The Fano Reference Is Not Prior Art As To Dependent Claims 205 And 207.*

Paragraph 7 of the Final Action rejected claims 205 and 207 under § 103(a) as being unpatentable over Malec in view of Fano (US Patent No. 6,317,718). The applicants first submit that the geographic aspects recited in claims 205 and 207 are fully supported by the parent Katz patent (No. 6,055,513) at least at column 9, lines 33-40; column 17, lines 50-55; and column 21, lines 45-50. These passages discuss various aspects of determining a customer's geographic location by obtaining and analyzing the telephone number from which the customer dialed a call to execute a primary transaction. Data representing the originating telephone is conventionally available through the ANI service, as discussed throughout the applicant's specification and as well known in the industry. Clearly, the ANI service provides data representing the telephone number from which the customer dialed a given telephone call to a call center in real time with the incoming call from the customer. Thus, when a customer dials a given telephone number to conduct a primary transaction from his/her home, the call center to which the dialed number terminates receives ANI data in real time with this primary transaction indicating from where the customer is calling. Further, in the parent Katz patent, the applicants discuss real time secondary (or upsell) transactions based on a variety of input data, including, e.g., demographic data. One illustrative form of input or demographic data is geographic designator data derived from ANI, as described in Katz '513 at least in column 17, lines 47-55. Clearly, those skilled in the art would recognize that offering an upsell in real time with a primary transaction based on various inputs requires gathering and processing those inputs in real time as well. Otherwise, any substantial delay in obtaining the inputs for the upsell will necessarily delay the upsell beyond real time.

In light of the above comments, the applicants submit that claims 205 and 207 have an effective filing date of 11 March 1998. Turning to the Fano '718 patent, its effective date as a reference is its filing date of 26 February 1999. Thus, the Fano '718 patent is not effective prior art against claims 205 and 207, and the applicants thus request reconsideration and withdrawal of the rejections based on this reference.

5. *New claims added herein by applicants further to distinguish from Malec by reciting data gathered in connection with a given primary transaction or a single primary transaction.*

In addition to the above discussion directed to independent claims 21 and 68, the applicants submit herein new claims directed to further features not believed shown by the cited

art, particularly Malec. New dependent claims 208 and 209 depend from independent claim 21, while new dependent claims 210 and 211 depend from independent claim 68. New independent and dependent claims 217, 218, 220, and 221 are added herein as well. These new claims recite various aspects related to gathering data representing the user's geographic position, the user's 5 identity, and a further data element related to the user in connection with one given or single primary transaction (new claims depending ultimately from independent claim 21 or independent claim 217), or gathering data representing the user's geographic position, the goods/service involved in the primary transaction, and the further data element in connection with one given or single primary transaction (new claims depending ultimately from independent claim 68 or 10 independent claim 220). The applicants submit that the parent Katz '513 patent fully supports these new claims at least at column 9, lines 20-65, discussing generally various aspects of processing a given primary transaction and describing the types of data that can be obtained in connection therewith.

Turning to page 6 the Final Action, Malec was interpreted as conducting two separate 15 actions to obtain the data recited in, e.g., the applicants' claim 21. First, the shopper swipes a smart card through the smart card reader, which results in Malec obtaining data residing on that card, such as data representing the identify of the shopper and any demographic data pertaining to the shopper. Second, the shopper must push the shopping cart into proximity with the trigger transmitters to enable the cart's on-board electronics to receive signals from the trigger 20 transmitters. Assuming that each trigger transmitter emits a unique signal, Malec may be able to determine the shopper's location when unique signals are received. However, under this interpretation of Malec, the applicants submit that the Malec shopper must conduct two separate "primary transactions" (i.e., first, swipe the smart card; second, push the cart into proximity with the trigger transmitters) to obtain data that is analogous to that recited in the applicants' claims 25 21 and 68. Put another way, Malec does not appear to disclose a single or given primary transaction that ultimately results in data representing the user's identity, a further data element, and the user's location. Malec gathers its data in connection with two primary transactions, while the applicants' claimed invention obtained its data in connection with one primary 30 transaction. On at least this basis, the applicants submit that Malec does not support a § 102(b) rejection of these new claims.

6. *New claims added herein by applicants further to distinguish from Malec by reciting using data representing the identity of the user to obtain data representing the geographic position of the user.*

In addition to the above discussion directed to independent claims 21 and 68, the
5 applicants submit herein new claims directed to further features not believed shown by the cited
art, particularly Malec. Claims 212 and 213 depend ultimately from independent claim 21,
claims 214-216 depend ultimately from claim 68, claim 219 depends from independent claim
217, and claims 222 and 223 depend ultimately from independent claim 220. These new claims
recite various aspects of using data representing the identity of the user to obtain data
10 representing the geographic position or location of the user when conducting the primary
transaction. The applicants submit that the parent Katz '513 patent fully supports these new
claims at least at column 17, lines 45-55. The applicants further submit that Malec does not
support a § 102(b) rejection of these new claims because to the extent that Malec can locate the
15 shopper's location, it does so completely separately and independently of any data identifying
the shopper. More particularly, Malec's trigger transmitters and associated transceiver
electronics in the shopping carts function independently of and separately from the smart card
reader. On at least this basis, the applicants submit that Malec would not support a § 102(b)
rejection of these new claims.

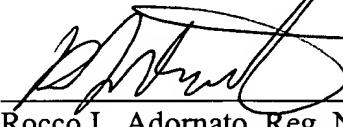
The applicants request favorable action at the earliest convenience of the Office. If
20 discussion of this application or this response would advance prosecution of the instant
application, the Office is requested to contact Rocco Adornato at the telephone number indicated
below.

Respectfully submitted,

25 WEST CORPORATION

Dated: 6 AUG 04

By:


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